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Katrin Reisinger

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SCHIFF HARDIN, LLP
PATENT DEPARTMENT
233 S. Wacker Drive-Suite 6600
CHICAGO, IL 60606-6473

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NELSON, FREDA ANN

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KATRIN REISINGER

Appeal 2009-007423
Application 10/797,838
Technology Center 3600

Decided: June 4, 2010

Before LINDA E. HORNER, JOHN C. KERINS, and
FRED A. SILVERBERG, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*

DECISION ON APPEAL

STATEMENT OF THE CASE

Katrin Reisinger (Appellant) seeks our review under 35 U.S.C. § 134 of the Examiner's decision rejecting claims 1-4. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We REVERSE and enter a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

THE INVENTION

Appellant's claimed invention is a mail-processing device for automatically determining a product code and a product description for a service product based on mail-item-related data values and tables containing such product codes and product descriptions, and supplying as output a text for the product description for generating a printout. Claims App'x, Claim 1. Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A mail-processing device comprising:
 - a microprocessor;
 - a keyboard with operating elements connected to said microprocessor for entering shipping information into said microprocessor;
 - a working memory accessible by said microprocessor containing mail-item-related data values;
 - a programmable memory and a program memory accessible by said microprocessor;
 - in at least one of said program memory and said

programmable memory,

a first memory area containing a program that evaluates said mail-item-related data values stored in the working memory to cause said mail-item-related data values to be permanently or temporarily stored,

a second memory area containing a first table for indices respectively assigned to different country-specific, postal authority-defined product codes, said product codes being ascendingly or consecutively stored in said table in a column and said table having a second column, in parallel with said first column, containing indices for different product descriptions, and

a third memory range for storage of a further table for said product descriptions respectively assigned to said indices in said second column; and

said microprocessor being programmed by said program for evaluating the mail-item-related data values stored in the working memory by accessing said table containing said first and second columns to automatically determine a product code and a product description for said service product, and to supply as an output a text for said product description for generating a printout thereof.

THE REJECTION

Appellant seeks review of the Examiner's rejection of claims 1-4 under 35 U.S.C. § 103(a) as being unpatentable over Schuricht (US 5,040,132) and Ulvr (US 5,602,382).

ISSUE

The Examiner found that Schuricht discloses the mail-processing device as claimed except that it does not disclose country-specific codes.

Ans. 4-5. The Examiner found that Ulvr teaches country-specific codes and concluded that it would have been obvious to modify Schuricht to include country-specific codes for the advantage of complying with the postal code requirements of other countries when necessary during mail processing. *Id.*

Appellant contends while “[i]t is true that the Schuricht et al. reference discloses *storage* of certain types of codes associated with certain types of services” these codes are not the governmentally-defined product codes of the claims. App. Br. 5. Appellant further argues that “there is no automatic retrieval of [a] product code for inclusion in the franking imprint disclosed in the Schuricht et al. reference.” *Id.* Appellant further argues that Ulvr does not “provide any guidance to a person of ordinary skill in the field of designing postage meters with regard to the incorporation of an automatic designation of a product code in such a postage meter” and that “the country-specific codes disclosed in the Ulvr et al reference are country-codes, and are not (and could not be) product codes.” App. Br. 5-6.

The issue presented by this appeal is:

Would the claimed mail-processing device, including a memory area containing a table for indices assigned to different country-specific, postal authority-defined product codes and a microprocessor programmed to evaluate mail-item-related data values to automatically determine a product code, have been obvious in view of Schuricht and Ulvr?

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d

1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Schuricht discloses a mail-processing system that allows a user to enter carrier and shipping mode information, such as overnight air express, parcel post, and air and surface freight, into an information block 14 in the memory of the system. Schuricht, col. 3, ll. 15-21.
2. Schuricht discloses that each information block 14 contains three associated blocks, one of which represents a rate code section for storing pointer information to identify the applicable transportation rate table for the shipping mode identified by the information block 14. Schuricht, col. 3, ll. 21-27 and ll. 46-49.
3. The transportation rate tables are each stored in information blocks 15, and have storage locations accessible by look-up using the zone of, or the distance to, the destination and the weight value of the article to be shipped. Schuricht, col. 3, ll. 56-68. Thus, Schuricht's system automatically determines the transportation rate value for an article by reference to a look-up table, based on data related to the article, such as the zone or location to which the article is to be shipped and the weight of the article to be shipped.
4. Schuricht discloses that "in some countries public carriers like postal services or train services use zone-structured rate tables." Schuricht, col. 4, ll. 1-3.

5. Schuricht discloses that one or more information blocks 15 may also include associated supplementary information corresponding to optional extra services and supplementary rates. Schuricht, col. 4, ll. 30-37.
6. Schuricht discloses that information blocks 16 contain control commands and text information data required to cause the printer to print out the form(s) required for a certain shipping mode for a carrier. Schuricht, col. 1, ll. 46-61; *id.* at col. 4, ll. 42-51.
7. Schuricht uses information stored in memory, including the information input by the user that is stored in information blocks 13, 14, and 15, to automatically complete the information required for the forms for print-out. Schuricht, col. 4, ll. 42-51; *id.* at col. 6, l. 58 – col. 7, l. 4.
8. Schuricht further discloses automatically storing codes representing a recipient's preferred mode of shipping and preferred special service, such as express shipping, so that this information can be automatically accessed without any need for the user to manually enter a shipping mode and/or special service. Schuricht, col. 9, l. 55 – col. 10, l. 9.
9. Appellant admits that at the time of filing of Appellant's application, governmental postal authorities in some countries, such as in Germany and Canada, defined product codes to include additional services beyond basic mailing, such as overnight delivery, registered mail, etc., and that these postal authorities

required such product codes to be included in the franking imprint on the article, which necessitated an additional entry by the operator. App. Br. 3, 12; Spec. 3.

10. Appellant admits that such a product code is “simply a number.” App. Br. 3.
11. Appellant admits that Ulvr discloses “automated entry of country codes.” App. Br. 7.
12. Ulvr discloses a mail piece bearing “a bar codeword containing information for the processing of the mail piece, the bar codeword having a plurality of parallel bars each of which has a state selected from a plurality of possible states.” Ulvr, col. 1, l. 66 – col. 2, l. 3.
13. Ulvr discloses that “[n]ot only postal (sortation and sequencing) data can be encoded but also customer data to support the creation of value added products and services selectable by the customer at the time of printing the mail pieces.” Ulvr, col. 2, ll. 21-24.
14. Ulvr further discloses an example of a global code to be used when the mail piece is addressed to another country. This global code includes a country code, which is found by consulting a table. Ulvr, col. 9, ll. 24-49; Table 1.

PRINCIPLES OF LAW

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

The Court in *KSR* noted:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida* [*v. Ag Pro, Inc.*, 425 U.S. 273 (1976)] and *Anderson's-Black Rock[, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969)] are illustrative—a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

550 U.S. at 417. The Court further noted:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an

apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR, 550 U.S. at 418.

ANALYSIS

The Examiner concluded that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schuricht to have included country-specific codes as taught by Ulvr et al. for the advantage of comply with the postal code requirements of other countrys when necessary during mail processing.” Ans. 5. We agree with Appellant that the Examiner’s conclusion of obviousness fails to take into account the fact that neither Schuricht nor Ulvr discloses the claimed “country-specific, postal authority-defined product codes.” As such, we cannot sustain the Examiner’s rejection of claims 1-4 under § 103(a) as articulated. It is our conclusion, however, that the subject matter of at least claim 1 would have been obvious in view of the prior art of record. As such, we enter a new ground of rejection of claim 1 and leave it to the Examiner to

reconsider the patentability of dependent claims 2-4 in light of this new ground of rejection.

Appellant describes the invention's improvement over the conventional method of manual-entry of product codes as follows:

In accordance with the present invention, all of the available services from the postal authority are displayed to the user in a menu. The user then selects the desired service from the menu. It still remains, however, to identify the postal authority-defined product code for the selective service. Conventionally, this would have required the user to then peruse another menu showing the product codes, and the user would then have to select the appropriate product code. In accordance with the present invention, this extra step on the part of the user is eliminated by automatically identifying and selecting the appropriate product code, from a stored table, simply upon the initial entry by the user of the appropriate shipping information.

App. Br. 4. In light of the Appellant's characterization of the invention, the issue before us is reduced to whether one having ordinary skill in the art would have been led to use a table to automatically look up country-specific, postal authority-defined product codes for articles to be mailed, in view of Schuricht and Ulvr.

The disclosure in Schuricht shows that it was known in the art at the time of filing of Appellant's application to have a mail-processing system that uses user-entered shipping information (such as service-related information and article weight information) to automatically look-up an associated transportation rate using rate tables (Facts 1-5). It was also known in the art at the time of filing that different countries have different rate structures and thus different rate tables (Fact 4). It was further known in

the art to have a microprocessor programmed to use the user-entered information and the automatically-generated rate information to automatically complete and print out shipping forms for specific carriers (Facts 6 and 7). Schuricht does not teach looking up country-specific, postal authority-defined, product codes for an article from a table and supplying as output a text for a product description associated with the product code.

Appellant admits that, at the time of Appellant's application, governmental postal authorities in some countries required product codes, i.e., a number that identifies additional services, to be entered so that the product code information is included in the franking imprint on the article, which necessitated an additional entry by the operator (Facts 9 and 10). As such, there was a demand in the marketplace at the time of Appellant's application to include such country-specific, postal-authority-defined, product code information in the franking imprint on the article. Schuricht further discloses that it was desirable in this art at the time of Appellant's application to devise ways to save the user from having to manually enter information (Fact 8). Schuricht further discloses the concept of automatically retrieving information from tables (i.e., rate tables) based on user-entered information, and printing this automatically-retrieved information on forms that are used to ship the articles (Fact 3). Further, both Schuricht and Ulvr recognize that certain information to be used for shipping articles is country-specific, e.g., country-specific zone-structured rate tables and country codes, and that this information can be automatically retrieved through the use of tables (Facts 4 and 14). Both Schuricht and Ulvr also

disclose that it was known at the time of Appellant's application to include codes representative of value-added products and services in the printed information used for shipping the articles, e.g., printed forms or bar codes (Facts 8, 12, & 13).

In view of the market demand at the time of Appellant's application to include country-specific, postal-authority-defined, product code information in the franking imprint on an article and based on state of the art and the desire in the art to save the user from having to manually enter information on articles to be shipped, we conclude that it would have been obvious to modify Schuricht's mail-processing system to include an additional table to be used to look-up known country-specific, postal-authority-defined, product codes based on user-entered information, and to provide this automatically-identified, product code information as output for use in shipping the article. A person having ordinary skill in the art would have been led to so modify Schuricht's system for two reasons: first, to meet the market demand to include such product code information in the franking imprint on the article; and second, to save the user from having to manually enter information on articles to be shipped, in keeping with Schuricht's own identified desire to minimize information that had to be entered by the user. Since the concept of using tables to automatically identify information that is to be printed for shipping of the article was known in the art, such a modification to Schuricht to add another table to identify product codes would have been a predictable variation on Schuricht's mail-processing system and would not have been beyond the level of skill of one having ordinary skill in the art.

The fact that the governmentally-defined product codes were not in existence at the time of Schuricht and Ulvr is of no moment because the obviousness inquiry is made at the time the *Appellant's* invention was made. *See KSR*, 550 U.S. at 406 (quoting 35 U.S.C. § 103(a), which forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious *at the time the invention was made* to a person having ordinary skill in the art to which said subject matter pertains.” (emphasis added)). As Appellant admits that at the time of filing certain governments used and required such product code information in the franking imprint, this acknowledged market need, in combination with the state of the art as demonstrated by Schuricht and Ulvr, renders the Appellant’s claimed invention obvious to one having ordinary skill in the art at the time of filing of Appellant’s application.

CONCLUSION

The claimed mail-processing device, including a memory area containing a table for indices assigned to different country-specific, postal authority-defined product codes and a microprocessor programmed to evaluate mail-item-related data values to automatically determine a product code, would have been obvious to one having ordinary skill in the art at the time of Appellant’s invention in view of Schuricht and Ulvr.

DECISION

The decision of the Examiner to reject claims 1-4 is REVERSED.

Appeal 2009-007423
Application 10/797,838

We enter a new ground of rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Schuricht, Ulvr, and Appellant's Admitted Prior Art.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED; 37 C.F.R. § 41.50(b)

nhl

Appeal 2009-007423
Application 10/797,838

SCHIFF HARDIN LLP
PATENT DEPARTMENT
233 S. WACKER DRIVE SUITE 6600
CHICAGO IL 60606-6473